REMARKS

This application has been reviewed in light of the Office Action dated March 22, 2007. Claims 1-5, 7-22, 24-27, 30-33, 35-54, 56-58, 61, and 66-77 are presented for examination. Claims 8 and 33 have been amended to define more clearly what Applicant regards as his invention. Claims 1, 3, 5, 33, 58, 61, 66, 69, 70, 71, 74, and 75 are in independent form. Favorable reconsideration is requested.

As an initial matter, at page 2 of the Office Action (in the *Response to Amendments* section) the Examiner states that limitations introduced using terms such as "when", "if", "may", or "can" does not further limit the claims, and therefore cannot be relied upon to distinguish claims from the prior art. However, the language referred to by the Examiner indicate the conditions under which a claimed step is performed, i.e., the step is performed "if" or "when" a certain condition exists. U.S. patent practice *is replete with this type of claim language*. MPEP § 2143.03 provides:

> To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). (Emphasis Added.)

Accordingly, Applicant respectfully requests that the Examiner consider all of the words in the claims in judging their patentability, as the patent law and rules require.

The Examiner also states, at page 2 of the Office Action, that "what a computer 'is adapted for' (e.g. claim 33) also does not distinguish a claimed apparatus from a prior art apparatus as it is intended use". While Applicants disagree with the Examiner, in

order to advance prosecution and facilitate allowance Claim 33 has been amended to recite "configured to" rather than "adapted to". Applicants do not concede the propriety of the rejection.

Claims 1-5, 7-22, 25-27, 30, 32, 33, 36-58, 61, AND 66-77 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Examiner takes issue with the limitation that the user defined parameters are not used by the information appliance to perform a search for the content.

The relevant question under 35 U.S.C. § 112, second paragraph is "whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity." M.P.E.P. § 2173.02. "Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made." Id.

The Examiner states that "it is not clear to one of ordinary skill how Applicant's system can prevent a user from entering user defined parameters and then using the same parameters to query a database." (Office Action at page 5.) However, there is nothing in Applicant's disclosure or the teachings of the prior art to support this interpretation. Neither is there any reason to believe that this is the interpretation that would be reached by one of ordinary skill in the art.

As one of ordinary skill in the art would readily appreciate, the claims recite that the parameters are not used to perform a search for the content, i.e., the content selected by the user, so it does not make any sense whatsoever to suppose that the user

would use these parameters to perform a search for content that has already been selected. For example, the method of Claim 5 recites "accessing, through the network, **selected** content…". (Emphasis added.) Moreover, one of the objectives of the invention is to enable the user to set user defined parameters and proceed with uninterrupted retrieval of fee-based content. Re-entering these parameters after the content has been selected would be contrary to this objective and, moreover, would further no useful purpose.

The claims recite that the user-defined parameters are not used by the information appliance to perform a search for the content, which forecloses the interpretation put forth by the Examiner.

The Examiner states at page 5 of the Office Action:

> Claims 25, 26, 54, 56, 76, and 77 recite storing user-preferences at a remote location. Claims 5 and 33, from which the above claims depend, recite storing user-preferences at a user computer. According to the Specification (page/line 39/17-38/7) these embodiments of Applicant's system are mutually exclusive therefore the operation of Claims 25, 26, 54, 56, 76, and 77 are unclear to one of ordinary skill.

The Examiner's comments are not understood. In particular, the Examiner's reference to "page/line 39/17-38/7" is not understood. Neither page 38 nor page 39 appears to Applicant to relate to the Examiner's comments insofar as Applicant understands them. Applicant requests that the Examiner clarify his comments or withdraw the rejection.

Accordingly, withdrawal of the rejections under 35 U.S.C. § 112, second paragraph is respectfully requested.

Claims 1-5, 7-22, 24, 27, 30-33, 36, 37, 39-44, 46-53, 57, 58, 61, and 66-77 were rejected under 35 U.S.C. § 103(a) as obvious over U.S. Patent No. 5,892,900 ("Ginter"), or as obvious over Ginter in view of U.S. Patent No. 6,073,124 ("Krishnan"). Claims 25, 26, 54, and 56 were rejected as obvious over Ginter in view of U.S. Patent No. 5,878,141 ("Daly"), or as obvious over Ginter in view of Krishnan and further in view of Daly. Claim 38 was rejected as obvious over Ginter in view of U.S. Patent No. 5,500,513 ("Langhans"), or as obvious over Ginter in view of Krishnan and further in view of Langhans. Claim 45 was rejected as obvious over Ginter in view of U.S. Patent No. 5,892,900 ("Casement"), or as obvious over Ginter in view of Krishnan and further in view of Casement.

Generally speaking, the present invention provides a convenient way of accumulating and processing payments for electronic content. More specifically, the invention provides systems and methods by which a user can seamlessly obtain content requiring a fee, such that numerous fees may be accumulated at a third party server and billed to the user's credit or debit card, rather than billing each individual transaction to a credit or debit card, which would result in delay due to the conventional credit/debit transaction initiation and approval processes. Accordingly, the present invention provides a seamless way of browsing through fee-based content without the need for the user to enter payment information for each individual transaction in order to obtain each piece of content.

Claim 5, for example, is directed to a method for accessing content over a network. The method includes:

(a) establishing an account at a third party billing server (see, e.g., specification at page 30, lines 10-15);

(b) storing, at the third party billing server, user account information including an account identifier generated by the third party billing server, an account balance and at least one of a credit card number and a debit card number associated with an account held by the user, apart from the account established at the third party billing server (see, e.g., specification at page 14, last paragraph);

(c) storing account information on a user's information appliance, including an account identifier of the user and at least one predefined user-preference (see, e.g., specification at page 18);

(d) accessing, through the network, selected content that requires a fee to be accessed, based on the at least one predefined user-preference, specified by the user, pre-authorizing payment for content requiring a fee, and without obtaining further user input specifying a payment authorization or a payment method selection prior to the accessing (the at least one predefined user-preference is not used by the user's information appliance to perform a search for the content and the selecting of the content is not dependent on the at least one predefined user-preference);

(e) retrieving the account information stored on the information appliance when the selected content requires a fee;

(f) transmitting the account identifier and an amount of the fee to a third party billing server (see, e.g., specification at page 18); and

(g) accumulating fees to account for all those incurred for accessing each selected content accessed in the accessing.

(h) billing the user for the accumulated fees through the credit card number or debit card number associated with the account held by the user, apart from the

account established at the third party billing server (see, e.g., specification at page 43, first full paragraph).

Applicant strongly submits that the cited references do not teach or suggest this combination of features.

The general nature of Ginter has been discussed adequately in previous papers, and it is not believed to be necessary to repeat that entire discussion. Briefly, Ginter relates to a system for controlling the distribution and use of electronic content by creating a virtual distributed environment (VDE), which is a combination of hardware and software components that create a desired rights environment for the use of electronic content.

Ginter does not teach or suggest establishing an account at a third party billing server and storing, at the third party billing server, user account information including an account identifier generated by the third party billing server, an account balance and at least one of a credit card number and a debit card number associated with an account held by the user, apart from the account established at the third party billing server, as recited in Claim 5. Nor does Ginter teach or suggest storing account information on a user's information appliance, including an account identifier of the user and at least one predefined user-preference, retrieving the account information stored on the information appliance when the selected content requires a fee, and transmitting the account identifier and an amount of the fee to a third party billing server, as further recited in Claim 5. Nor does Ginter teach or suggest accumulating fees to account for all those incurred for accessing each selected content and billing the user for the accumulated fees through the credit card number or debit card number associated with the account held by the user, apart from the account established at the third party billing server, as further recited in Claim 5.

The Examiner states the following at page 8 of the Office Action:

> Regarding third party providers (e.g. credit card company, financial institutions) and accumulating a plurality of fees, Ginter et al. disclose a user paying for content using a credit or debit card (e.g. VISA) (column/line 290/60-291/16), hence Ginter et al. discloses third party providers that accumulate fees, a user making payments and overpayments (e.g. claim 48) to a third party provider, individual and accumulated fee thresholds, and said provider accumulating user charges, verifying fees, billing a user, storing user account and paying a content provider on behalf of a user.

Further, the Examiner states the following at page 3 of the Office Action:

> Ginter et al. teaches a third party billing server such as a credit or debit card company computer system which receives information regarding a credit or debit purchase (column/line 40/63-41/24; column 187, lines 11-30; column/line 290/60-291/16). The computer system would also generate an account and account identifier for the credit or debit card.

However, the payments discussed in Ginter are merely conventional credit card or debit payments; accordingly, any account in Ginter is merely a conventional credit or debit account (e.g., a VISA account). Ginter does not teach or suggest accumulating fees at a third party server and then billing the accumulated fees to a credit or debit card. In the method of Claim 5, in stark contrast to Ginter, an account is established at a third party billing server and user account information is stored at the third party billing server including at least one of a credit card number and a debit card number associated with an account held by the user, apart from the account established at the third party billing server. The Examiner is simply ignoring this language of Claim 5.

For example, as quoted above the Examiner states that "Ginter et al. teaches a third party billing server such as a credit or debit card company computer system which

receives information regarding a credit or debit purchase," and "The computer system would also generate an account and account identifier for the credit or debit card." However, the Examiner does not point to any teaching in Ginter et al. of storing, at a third party billing server, along with an account identifier generated by the third party billing server, at least one of a credit card number and a debit card number associated with an account held by the user, apart from the account established at the third party server. Once again, Applicant points out that the Examiner is simply ignoring this language of Claim 5.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP § 2143.03 (citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)). "All words in a claim must be considered in judging the patentability of that claim against the prior art." MPEP § 2143.03 (quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). To establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. § 2143.

As is clear from the features discussed above, Claim 5 is directed to a method for accumulating fees at a third party server and then billing the accumulated fees to a credit or debit card. Ginter simply does not contemplate such a configuration. Ginter merely discusses creating a "budget" (e.g., a VISA budget, a company budget, or a family budget) using a conventional credit card or debit account.

Furthermore, at page 9 of the Office Action, the Examiner states:

> Ginter et al. also teach programmable smart objects that search remote computer systems for specific content based on user search parameters (column 264, lines 52-57;

> column 265, lines 20-38; column 266, lines 22-38). Specifically, Ginter et al. teach software objects governed by "at least one rule and/or control associated with the software agent that governs the agent's operation". Hence, an obvious application of Ginter et al. is for creating a software object that only retrieves content from TimeWarner intellectual property sites (figure 72D) and apply budget constraints such as a spending maximum of 15 US dollars (column 266, lines 27-39).

Applicant is unable to understand why the Examiner is reading a search feature of Ginter on Applicant's claims. Plainly put, the method of Claim 5 is not a search engine, and does not search or select content based on a predefined user-preference; rather, the method of Claim 5 decides whether to access content, already selected, that requires a fee to be accessed, based on the at least one predefined user-preference, specified by the user, pre-authorizing payment for content requiring a fee. In fact, Claim 5 specifically recites "wherein the at least one predefined user-preference is not used by the user's information appliance to perform a search for the content", and recites "wherein the selecting of the content is not dependent on the at least one predefined user-preference". (Emphasis added.) Accordingly, any search feature in Ginter et al. is simply irrelevant to the method of Claim 5.

In the example provided in the cited portion of Ginter (i.e., column 266, lines 22-38), the smart object 3000 performs a library search using the "Very Fast and Efficient" software agent to search for books written about some subject of interest, and the search engine is designed to return a list of books to the user. This is wholly irrelevant to the method of Claim 5, since, as noted, the method of Claim 5 does not search or select content based on a predefined user-preference.

At page 9 of the Office Action the Examiner states:

> Regarding fees that exceed a predetermined amount, messages from third party providers to users indicating "insufficient funds" or "overdrawn" are old and well-known, hence it would have been obvious to inform a user if he/she lacks the credit to obtain the desired content.

First, Applicant is unable to understand why the Examiner is reading a search feature of Ginter on Applicant's claims. Second, Applicant is unable to understand why the Examiner is reading the above aspect of Ginter on the claims. The Examiner is requested to carefully read the claims. The Examiner discusses "messages" from a credit card company to a user informing the user of insufficient funds. The method of Claim 5, on the other hand, recites at least one predefined user-preference, specified by the user (not by a credit card company or the like), pre-authorizing payment for content requiring a fee. By virtue of the claimed features, a user can seamlessly obtain content requiring a fee; for example, Claim 5 specifically recites "without obtaining further user input specifying a payment authorization or a payment method selection prior to the accessing". Applicant has found nothing in Ginter that would teach or suggest these features.

Accordingly, Claim 5 is seen to be clearly allowable over Ginter.

Independent Claims 1, 3, 33, 58, 61, 66, 69, 70, 71, 74, and 75 recite features similar to those discussed above with respect to Claim 5 and therefore are also believed to be patentable over Ginter for the reasons discussed above.

Krishnan, as understood by Applicant, relates to securely incorporating electronic information into an online purchasing application. Figs. 14-17 of Krishner, cited

by the Examiner, provide sample user interface display screens that are displayed by the licensing code (via a user interface library) to retrieve method of payment information. These display screens may be presented in response to requests from a licensing and purchasing broker, which generates and returns a secure electronic licensing certificate in response to a request to license the requested item of merchandise (see column 4, lines 32-27) for more information. (See column 20, lines 53-57, cited by the Examiner.)

The Examiner states the following at page 4 of the Office Action:

> On the other hand, Ginter et al. also teach credit and debit cards embodied as electronic wallets… Krishnan et al. teach electronic wallets stored on a user computer and using said wallet to purchase content (figures 12 and 14-18; column/line 20/54-21/21). Electronic wallets as browser plug-ins are old and well known. Therefore, it would have been obvious to combine the teachings of Ginter et al. and Krishnan et al. in order to allow a user to better keep track of the electronic wallet…

Applicant submits that nothing in Krishnan would supply what is missing from Ginter. Nor is it clear to Applicant what features of the claims Krishner is being applied against.

Fig. 14 of Krishnan, cited by the Examiner, is merely an example display screen for selecting a particular credit card (see column 20, lines 64-66). Fig. 17 of Krishnan, cited by the Examiner, is merely an example display screen for allowing a customer to verify an intent to purchase after supplying a method of payment (see column 21, lines 9-13). Both Fig. 14 of Krishnan, which asks the user to select a credit card to pay with, and Fig. 17 of Krishnan, which displays a list of charges to the user, teach away from the method of Claim 5. The method of Claim 5 includes accessing selected content that

requires a fee to be accessed, based on one predefined user-preference, pre-authorizing payment for content requiring a fee, and without obtaining further user input specifying a payment authorization or a payment method selection prior to the accessing. Nothing in Krishnan would teach or suggest these features.

By virtue of the features of Claim 5, a user can seamlessly obtain content requiring a fee, such that numerous fees may be accumulated at a third party server and billed to the user's credit or debit card, rather than billing each individual transaction to a credit or debit card, which would result in delay due to the conventional credit/debit transaction initiation and approval processes.

Accordingly, Claim 5 is seen to be clearly allowable over Ginter and Krishnan, whether considered separately or in any permissible combination (if any).

Independent Claims 1, 3, 33, 58, 61, 66, 69, 70, 71, 74, and 75 recite features similar to those discussed above with respect to Claim 5 and therefore are also believed to be patentable over Ginter and Krishnan for the reasons discussed above.

A review of the other cited references has failed to reveal anything which, in Applicant's opinion, would remedy the deficiencies of the art discussed above, as references against the independent claims herein. Those claims are therefore believed patentable over the art of record.

The other claims in this application are each dependent from one or another of the independent claims discussed above and are therefore believed patentable for the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

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